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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,158	01/15/2002	Yosato Hitaka	03500.016099	8868
5514 7590 03/04/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER MENBERU, BENIYAM	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/045,158	Applicant(s) HITAKA, YOSATO	
	Examiner Beniyam Menberu	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,24,25,27,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,24,25,27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 20-22, 24, 25, and 27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 24, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7042585 to Whitmarsh et al in view of U.S. Patent No. 6822754 to Shiohara further in view of U.S. Patent No. 6198542 to Tabata.

Regarding claim 20, Whitmarsh et al '585 discloses a user apparatus that communicates with a print management apparatus via a network (column 3, lines 24-30, 54-62; column 4, lines 37-46; The computer 34 is the user apparatus. The printer broker 28 is the print management apparatus using a network 30.), comprising:

print shop information obtaining means for notifying said print management apparatus of a use condition and obtaining, in advance, print shop information for a plurality of print shops each having a print ability corresponding to the notified use condition (column 9, lines 48-65; column 10, lines 1-27, 36-45; The print attributes of print job 12 is the use condition needed to generate the list 46(print shop information for a plurality of print shops) of providers with the necessary capability 40. In step 118 the user/customer obtains the list from the print broker 28 (print management apparatus).), from said print management apparatus;

print data forming means for setting a print condition by using a printer driver installed in said user apparatus and forming print data in accordance with the set print condition (column 4, lines 39-52; The "program" executing on computer 34 is the printer driver.; column 8, lines 60-66; The data file 44 (print data) is generated based on attribute information 72, 73, 76 (set print condition).). However Whitmarsh et al '585 does not disclose judgment means for judging whether each of the plurality of print shops included in the print shop information obtained in advance by said print shop information obtaining means can print the print data formed by said print data forming means, on the basis of the print condition of the print data and the print ability of the print shop.

Shiohara '754 discloses judgment means for judging whether each of the plurality of print shops included in the print shop information obtained in advance by said print shop information obtaining means can print the print data formed by said print data forming means, on the basis of the print condition of the print data and the print ability of the print shop (column 14, lines 27-43; The "print processing information" of all printers 31 is obtained (print shop information) in response to the temporary print request (print data formed; see (column 9, lines 52-67)) submitted to all the printers. Each printer 31 is judged to be match for print data based on printing content ("print condition") and printer 31 status (print ability). (column 14, lines 44-52; column 11, lines 6-67; column 12, lines 1-5).).

Having the system of *Whitmarsh et al '585* and then given the well-established teaching of *Shiohara '754*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Whitmarsh et al '585* as taught by *Shiohara '754*, since *Shiohara '754* stated in col. 2, Lines 11-30, such a modification would provide a faster printing system in a printing network.

However Whitmarsh et al '585 does not disclose screen information forming means for forming screen information for distinctively displaying print shops judged by said judgment means as a print shop which can print the formed print data, and print shops judged by said judgment means as a print shop which can not print the formed print data, in such a manner that the display of the print shops which can not print the formed print data indicates that such print shops are not selectable ; selection means for selecting a print shop to order print processing of the formed print data, from among the

print shops displayed as the print shops which can print the formed print data, on the basis of the formed screen information; and print order forming means for forming a print order, including the designation of the selected print shop.

Tabata '542 disclose forming screen information for distinctively displaying print shops judged by said judgment means as a print shop which can print the formed print data, and print shops judged by said judgment means as a print shop which can not print the formed print data, in such a manner that the display of the print shops which can not print the formed print data indicates that such print shops are not selectable (column 9, lines 29-47; column 10, lines 12-32; The inputted printing conditions by user (formed print data) are used to judge which of the plurality of image forming apparatus is capable of forming printing with respect to the conditions. As shown in Figure 9, there is a display of plurality of image forming apparatus (print shops), and it distinctively shows which ones are capable of printing. Only the second print shop is selectable because the other print shops are either occupied or have failure problems (see column 10, lines 24-26).) ; selection means for selecting a print shop to order print processing of the formed print data, from among the print shops displayed as the print shops which can print the formed print data, on the basis of the formed screen information (column 10, lines 26-34; The second print shop is selected as shown in Figure 9 with the "o" symbol.); and print order forming means for forming a print order, including the designation of the selected print shop (column 7, lines 12-27; The print button issues a print instruction (print order) to the Multi-function device 7.).

Having the system of *Whitmarsh et al '585* and then given the well-established teaching of *Tabata '542*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Whitmarsh et al '585* as taught by *Tabata '542*, since *Tabata '542* stated in col. 10, Lines 13-22, 43-54, such a modification would provide display information to a user based on imaging devices that satisfy one or more inputting condition with priority.

Regarding claim 24, *Whitmarsh et al '585* discloses an information processing system for processing information between a user apparatus and a print management apparatus through communication via a network (column 3, lines 24-30, 54-62; column 4, lines 37-46; The computer 34 is the user apparatus. The printer broker 28 is the print management apparatus using a network 30.), wherein said print management apparatus comprises:

print shop information searching means for searching for information of a plurality of print shops (column 9, lines 57-64; Printer broker 28 (print management apparatus searches for print providers 22 by searching the attribute information 80.); and print shop information transmitting means for transmitting the print shop information searched by the print shop information searching means to said user apparatus (column 11, lines 9-12, 22-26; The print provider list 46 is supplied to the user.),

and wherein said user apparatus comprises:

print shop information obtaining means for notifying the print management apparatus of a use condition and receiving the print shop information for the plurality of print shops

each having a print ability corresponding to the notified use condition, from the print shop information transmitting means (column 9, lines 48-65; column 10, lines 1-27, 36-45; The print attributes of print job 12 is the use condition needed to generate the list 46(print shop information for a plurality of print shops) of providers with the necessary capability 40. In step 118 the user/customer obtains the list from the print broker 28 (print management apparatus).);

print data forming means for setting a print condition by using a printer driver installed in said user apparatus and forming print data in accordance with the set print condition (column 4, lines 39-52; The "program" executing on computer 34 is the printer driver.; column 8, lines 60-66; The data file 44 (print data) is generated based on attribute information 72, 73, 76 (set print condition).). However Whitmarsh et al '585 does not disclose judgment means for judging whether each of the plurality of print shops included in the print shop information, obtained in advance by said print shop information obtaining means, can print the print data formed by said print data forming means, on the basis of the print condition of the print data and the print ability of the print shop.

Shiohara '754 discloses judgment means for judging whether each of the plurality of print shops included in the print shop information, obtained in advance by said print shop information obtaining means, can print the print data formed by said print data forming means, on the basis of the print condition of the print data and the print ability of the print shop (column 14, lines 27-43; The "print processing information" of all printers

31 is obtained (print shop information) in response to the temporary print request (print data formed; see (column 9, lines 52-67)) submitted to all the printers. Each printer 31 is judged to be match for print data based on printing content ("print condition") and printer 31 status (print ability). (column 14, lines 44-52; column 11, lines 6-67; column 12, lines 1-5).).

Having the system of *Whitmarsh et al '585* and then given the well-established teaching of *Shiohara '754*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Whitmarsh et al '585* as taught by *Shiohara '754*, since *Shiohara '754* stated in col. 2, Lines 11-30, such a modification would provide a faster printing system in a printing network.

However Whitmarsh et al '585 does not disclose screen information forming means for forming screen information for distinctively displaying print shops judged by said judgment means as a print shop which can print the formed print data, and print shops judged by said judgment means as a print shop which can not print the formed print data, in such a manner that the display of the print shops which can not print the print data indicates that such print shops are not selectable; selection means for selecting a print shop to order print processing of the formed print data, from among the print shops displayed as the print shops which can print the formed print data, on the basis of the formed screen information; and a print order forming means for forming a print order, including the designation of a the selected print shop.

Tabata '542 disclose screen information forming means for forming screen information for distinctively displaying print shops judged by said judgment means as a print shop which can print the formed print data, and print shops judged by said judgment means as a print shop which can not print the formed print data, in such a manner that the display of the print shops which can not print the print data indicates that such print shops are not selectable (column 9, lines 29-47; column 10, lines 12-32; The inputted printing conditions by user (formed print data) are used to judge which of the plurality of image forming apparatus is capable of forming printing with respect to the conditions. As shown in Figure 9, there is a display of plurality of image forming apparatus (print shops), and it distinctively shows which ones are capable of printing. Only the second print shop is selectable because the other print shops are either occupied or have failure problems (see column 10, lines 24-26).); selection means for selecting a print shop to order print processing of the formed print data, from among the print shops displayed as the print shops which can print the formed print data, on the basis of the formed screen information (column 10, lines 26-34; The second print shop is selected as shown in Figure 9 with the "o" symbol.); and a print order forming means for forming a print order, including the designation of a the selected print shop (column 7, lines 12-27; The print button issues a print instruction (print order) to the Multi-function device 7.).

Having the system of *Whitmarsh et al '585* and then given the well-established teaching of *Tabata '542*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Whitmarsh et al '585* as

taught by **Tabata '542**, since **Tabata '542** stated in col. 10, Lines 13-22, 43-54, such a modification would provide display information to a user based on imaging devices that satisfy one or more inputting condition with priority.

Regarding claim 25, see Rejection of claim 20 as shown above.

Regarding claim 27, see Rejection of claim 20 as shown above.

Regarding claim 29, Whitmarsh et al '585 in view of Shiohara '754 further in view of Tabata '542 teaches all the limitations of claim 20. Further Whitmarsh et al '585 discloses an apparatus according to claim 20, wherein each of the use condition and the print ability includes at least one of a page size, a media type, a page layout and a finishing option (column 10, lines 37-44; See "attributes").

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7042585 to Whitmarsh et al in view of U.S. Patent No. 6822754 to Shiohara further in view of U.S. Patent No. 6198542 to Tabata further in view of U.S. Patent No. 6804019 to Shiohara.

Regarding claim 30, Whitmarsh et al '585 in view of Shiohara '754 further in view of Tabata '542 teaches all the limitations of claim 20. However Whitmarsh et al '585 in view of Shiohara '754 further in view of Tabata '542 does not disclose inquiry means for inquiring of said print management apparatus about whether the print shop information of the print shop selected by said selection means has been updated; and update means for downloading the print shop information from said print management apparatus when said print management apparatus replies that the print shop

information has been updated, thereby updating the print shop information obtained by said print shop information obtaining means, wherein said selection means re-selects a print shop after said update means updates the print shop information.

Shiohara '019 discloses inquiry means for inquiring of said print management apparatus about whether the print shop information of the print shop selected by said selection means has been updated (column 9, lines 66-67; column 10, lines 1-5; Determination of registration reads on update.); and

update means for downloading the print shop information from said print management apparatus when said print management apparatus replies that the print shop information has been updated, thereby updating the print shop information obtained by said print shop information obtaining means (column 10, lines 6-14; The "Module configuration information" (print shop information) is received (downloading) when not registered. column 10, lines 31-36; Update occurs in step s20.),

wherein said selection means re-selects a print shop after said update means updates the print shop information (column 10, lines 32-38; printer 41 can be selected again.).

Having the system of *Hitaka '679* and then given the well-established teaching of *Shiohara '019*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Hitaka '679* as taught by *Shiohara '019*, since *Shiohara '019* stated in col. 1, lines 53-60, such a modification would provide compatibility among printers for processing print data.

Other Prior Art Cited

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6965958 to Sugiyama discloses network printers.

U.S. Patent No. 7127451 to Kimura discloses print searching system.

U.S. Patent No. 7170623 to Matoba et al discloses print server system.

U.S. Patent Application Publication No. US2007/0229880 A1 to Harmon et al discloses print job processing system.

U.S. Patent Application Publication No. US2001/0030766 A1 to Yamamoto discloses scanner/printer system.

U.S. Patent Application Publication No. US2004/0169884 A1 to Yamada et al discloses print system with email capability.

U.S. Patent Application Publication No. US2002/0163666 A1 to Iwata et al discloses printing system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

BM

02/28/2008



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SUPERVISORY PATENT EXAMINER
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